

Appl. No. 10/698,871
Atty. Docket No. 9084M
Amdt. dated January 9, 2006
Reply to Office Action of December 9, 2005
Customer No. 27752

REMARKS

Claims 1-22 are in the application.

Restriction Requirement

The Office Action alleges that Claims 1-22 are generic to a plurality of disclosed patentably distinct species comprising anionic monomers and nonionic monomers. The Office Action has required restriction under 35 U.S.C. § 121 to elect a single disclosed species of anionic and nonionic monomers, even though this requirement is traversed. The Office Action states that one method commensurate in scope with the elected composition will be searched and examined as well.

In accordance with the restriction requirement, Applicants' elect an anionic polymer monomer based on substituted or unsubstituted acrylic acids, and a nonionic monomer based on substituted or unsubstituted acrylates with traverse. Applicants traverse the present restriction requirement based on the following remarks.

Paramount to issuing a restriction requirement, the Manual of Patent Examining Procedure ("MPEP") describes the criteria for restriction as follows:

- (A) The inventions must be independent or distinct as claimed; and
- (B) There must be a serious burden on the examiner if restriction is not required.

MPEP § 803 (8th ed. 2003) (citations omitted). Furthermore, the MPEP requires that "Examiners must provide reasons and/or examples to support conclusions, but need not cite documents to support the requirement in most cases." MPEP § 803 (8th ed. 2003). Indeed, an Examiner must clearly provide reasons and/or examples to support how the claims define inventions that are independent or distinct, and further to show how there is a serious burden on the Examiner. The present Office Action provides no reasoning or examples of how Claims 1-22 define inventions that are independent or distinct, and no reasoning or examples to show how there is a serious burden on the Examiner to perform a search. Rather, the Office Action simply states that Claims 1-22 are generic to a plurality of patentably distinct species comprising monomers and nonionic monomers. There is no discussion as to how the species are distinct. Since the Office Action provides

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no reasoning or examples as to how the inventions are allegedly distinct, this restriction requirement is improper.

Even if the claims in an application contain inventions that are independent or distinct, a proper restriction also requires that there be a serious burden on the Examiner. See MPEP § 803(B) (8th ed. 2003). As the MPEP explains:

For purposes of the initial requirement, a serious burden on the examiner may be *prima facie* shown if the examiner shows by appropriate explanation either separate classification, separate status in the art, or a different field of search as defined in MPEP § 808.02. That *prima facie* showing may be rebutted by appropriate showings or evidence by the applicant.

MPEP § 803 (8th ed. 2003). Here, the Office Action does not provide the appropriate reasoning to support a *prima facie* case that a serious burden exists. Indeed, there is no discussion whatsoever as to the extent of the burden on the Examiner to perform the search. Since a serious burden on the Examiner has not been *prima facie* shown, the present restriction requirement is improper.

Based on the above remarks, reconsideration and withdrawal of the restriction requirement is respectfully requested. If, upon reconsideration, this restriction requirement is made final, Applicants respectfully request the next Office Action contain Form Paragraph 8.05 as suggested in MPEP § 821.01 (7th ed. 1998), to show that Applicants have traversed the requirement and have retained the right to petition from the requirement under 37 C.F.R. § 1.144.

CONCLUSION

In view of the foregoing remarks, reconsideration of the application, withdrawal of the restriction requirement, and allowance of all claims are respectfully requested.

Respectfully submitted,

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